

130-172

A/N

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kohno, et al.)

Serial No.: 08/259,413)

Group Art Unit:

Filed: June 14, 1994)

Examiner:

For: PEGYLATION REAGENTS)
AND COMPOUNDS FORMED)
THEREWITH)Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231**RECEIVED****APR - 4 1997****OFFICE OF PETITIONS
AND PATENTS****"EXPRESS MAIL" MAILING LABEL**

NUMBER: TB742886584

DATE OF DEPOSIT: January 3, 1995

I hereby certify that this paper is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231


Wendy J. DeSantisPETITION UNDER 37 CFR SECTION 1.47(a)

Dear Sir:

Joint inventors Hiko Kohno and David Kachensky (the "Joint Inventors") hereby petition the Commissioner to accept the above-identified application (the "Application") on their behalf and on behalf of Dr. Milton Harris in accordance with 37 CFR § 1.43(a) and M.P.E.P. § 409.03. On December 20, 1994, Dr. Harris refused to execute the declaration for the Application.

Enclosed herewith is an executed Declaration and Power of Attorney made by the Joint Inventors on their own behalf and on behalf of Dr. Harris. Theresa A. Brown, Esq., the person to whom the refusal was made, see M.P.E.P. § 409.03(e), is submitting her declaration this day under separate cover. The Brown Declaration

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provides proof of (a) Dr. Harris' refusal to execute the declaration for the application and (b) the circumstances of this refusal.

The Brown Declaration shows that:

(1) Dr. Harris had an opportunity to review drafts of the present application that were in all relevant respects substantially the same as the pending application. In fact, Dr. Harris provided technical input and comments regarding the present application. (Brown Declaration ¶¶ 9, 10, and 11)

(2) Dr. Harris was aware at least by June 9, 1994 that Synergen had planned to file the present application on June 13. Despite this understanding, Dr. Harris did not refuse to sign a declaration until well after the application was filed. (Brown Declaration ¶¶ 12, 13, 18 and 19)

(3) In fact, it was not until December 20, 1994 that Dr. Harris first refused to execute the declaration. (Brown Declaration ¶ 19).

Note that M.P.E.P. § 409.03 states that "[a] bona fide attempt must be made to comply with the provisions of 37 CFR § 1.47 at the time the application papers are first submitted." A joint inventor, however, cannot petition the Commissioner on behalf of a non-signing inventor prior to concluding the inventor had refused to sign. Therefore, when a joint inventor concludes after an application is filed that an inventor has refused to join in the application, a petition pursuant to 37 CFR § 1.47 need not be submitted when the application is first filed.

The Brown Declaration shows that Dr. Harris did not refuse to execute the Declaration until well after the Application papers were first submitted. Therefore, this Petition is timely.

The Brown Declaration includes relevant portions of an agreement between Shearwater Polymers, of which Dr. Harris is President, and Synergen, Inc., to which the Joint Inventors are required to assign the present application. Upon the written request of the Patent and Trademark Office, the petitioners will make other parts of this agreement available.

The last known address of Dr. Milton Harris is: 3119 Highland Plaza, Huntsville, Alabama 35801. Another address at which Dr. Harris can be reached is: c/o Shearwater Polymers, Inc., 2130 Memorial Parkway S.W., Huntsville, Alabama 35801.

A check for \$130.00, the amount set forth in 37 CFR § 1.17(h), is enclosed.

Also enclosed are duplicate Petitions for a four-month extension of time in which to respond to the Notice to File Missing Parts with the required fee.

In addition, enclosed is a copy of the Notice to File Missing Parts and a check for the surcharge of \$130.00, the amount set forth in 37 CFR § 1.16(e).


You are hereby authorized to charge any deficiency or deposit any excess associated with this communication to Deposit Account No. 18-2078. A duplicate of this Petition is enclosed.

Serial No. 08/259,413

Respectfully submitted this 3rd day of January, 1995.

ROTHGERBER, APPEL, POWERS & JOHNSON

By:


Nancy J. Desantis
Registration No. 37,608
1200 Seventeenth Street
Suite 3000
Denver, Colorado 80202
(303) 623-9000

Attorney for Applicants